

REMARKS

Brief Summary of File History:

Subsequent to the filing of the Notice of Appeal received by the U.S. Patent and Trademark Office on September 29, 2009, the Applicant submitted a Brief on Appeal in response to the rejection set forth in the Office Action dated June 29, 2009. Although the Applicant was not under Final in the June 29th Office Action, the Applicant was entitled to Appellate Review because the claims had been twice rejected (see 37 CFR §41.31).

In response to the mailing of the Examiner's Answer on February 26, 2010 (and the updated Answer mailed on March 29, 2010), the Applicant submitted a Reply Brief in accordance with 37 CFR §41.41. The Applicant also concurrently filed a Petition with the Director of the USPTO and the Director of Patent Technology Center 1700 pursuant to at least one of 37 CFR §§1.182, 1.183 and/or MPEP §§1002, 1002.02(c) requesting entry of new evidence into the file wrapper for consideration by the Examiner and the Board.

On July 15, 2010, the Board of Patent Appeals and Interferences issued an Order Remanding Appeal To Examiner to await a decision on the Petition. On August 11, 2010, the Director of Technology Center 1700 issued a negative decision on Appellant's Petition.

In view of the above, the Applicant herein files an RCE and the instant Response in accordance with MPEP §1215.01 and 37 CFR §1.114(c) to withdraw the application from Appeal and to reopen prosecution. Quite simply, the Applicant files this Response and the RCE and respectfully requests that the Examiner to consider the evidence submitted with the previous Reply Brief. For that reason, the instant Response expressly incorporates by reference the Reply Brief filed on April 26, 2010 and all evidence filed concurrently therewith in their entirety. For the

convenience of the Examiner and for completeness of the file wrapper, the Applicant herein includes a copy of the Reply Brief and evidence in an Exhibit to the instant Response.

Status of the Claims:

Claims 1-9 and 11-20 are pending in the instant application. Each of claims 1-9 stand “Previously Presented.” Therefore, each of these claims has been amended at least once from its original form. Claim 10 stands cancelled. Claims 11-20 were added to the original claims and also stand “Previously Presented.” Claim 12 has been amended at least once from its original form after its addition. No claims are added, amended, or cancelled in the instant Response. Moreover, no amendments have been filed subsequent to the non-final rejection mailed June 29, 2009 or subsequent to the Appeal Brief filed on November 30, 2009.

Claim Rejections:

Claims 1-9 and 11-20 stand rejected under 35 U.S.C. §103 as obvious over a combination of U.S. Pat. No. 6,737,458 to Woerner et al. in view of U.S. Pat. No. 4,677,141 to Cornelius et al. The Applicant respectfully asserts that the pending claims are both novel and non-obvious over the prior art.

Resolution of the Graham Inquiries:

The Applicant and the Examiner disagree as to the resolution of the *Graham* inquiries¹ – (1) the scope and content of the ‘458 and ‘141 patents, (2) the differences between these patents and the claimed invention, and (3) the level of ordinary skill in the silicone art as it affects (1) and (2) from above and the determination of obviousness in this matter. The resolution of the *Graham* inquiries, and the central issue for determination, can be summarized in the question of whether the ‘458 and ‘141 patents, taken alone or in combination, disclose, teach, or suggest the formation of particular “silicone elastomers” without the use of reinforcing fillers as recognized

¹ *KSR Int'l v. Teleflex*, 550 U.S. 398 (2006); *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

and appreciated by those of ordinary skill in the art.^{2,3} If the answer is “no,” then the ‘458 and ‘141 patents are inapplicable and do not render the claims obvious because the claims positively recite that the claimed silicone rubber composition is *free of* reinforcing fillers.

The Applicant previously filed a Declaration from an expert in the field of silicone rubber development and formulation, along with supplementary attorney arguments, to explain to the Examiner why the ‘458 and ‘141 patents do not teach each and every element of the claimed invention (as related to *Graham* inquiries (1) and (2)) and why those of skill in the art would not combine these references (as related to *Graham* inquiry (3)). However, the Examiner did not then accept, and continues to reject, the assertions made in the Declaration as incorrect and self-serving. In the Examiner’s Answer, filed during the pendency of the previous Appeal, the Examiner suggested that additional evidence would be needed to corroborate the assertions of the Declaration and to properly determine obviousness.

In a Reply Brief, the Applicant submitted additional evidence to support the assertions made in the Declaration. The Applicant also filed a Petition with the Technology Center Director to allow the additional evidence to be entered in the Appeal. In view of the negative decision on the Petition, the Applicant hereby respectfully re-submits the evidence and the Reply Brief for the Examiner’s review and consideration. In so doing, the Applicant asserts that the Declaration and evidence clearly resolve the *Graham* inquiries and prove, by well more than a preponderance of the evidence, that the claimed invention is non-obvious.

² For the sake of simplicity in view of the double negative language, the Applicant respectfully submits that the issue can be restated as whether the particular silicone elastomers of the ‘458 and ‘141 patent require the inclusion of reinforcing fillers, as recognized and appreciated by those of skill in the art.

³ “[w]hat matters in the § 103 obviousness determination is whether *a person of ordinary skill in the art*, having all the teachings of the [prior art] references before him, is able to produce the structure defined by the claim.” (emphasis added) See *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1013, 217 USPQ 193, 200 (Fed.Cir. 1983)

What is Recognized By Those of Ordinary Skill in Art of Silicone Formulation:

The Applicant respectfully submits that the Declaration, in conjunction with the eight independent references submitted herewith, set forth in great detail that those of skill in art of silicone formulation clearly recognize each of the following that correspond to, and clearly resolve, the three *Graham* inquiries:

- (1) that the ‘458 and ‘141 patents teach formation of “silicone elastomers” and these particular “elastomers” require inclusion of reinforcing fillers;
- (2) that the teachings of the ‘458 and ‘141 patents are clearly different from the scope of the instant claims because these claims positively recite that the claimed silicone rubber composition is free of reinforcing fillers; and
- (3) that the teachings ‘458 and ‘141 patents would not be obviously combined or, even if combined, would still form elastomers that require inclusion of reinforcing fillers⁴.

For the ease and convenience of the Examiner, the Applicant (in the previously filed Reply Brief) characterized each of the attached eight references based on their source and general applicability to this invention and highlighted particular passages that are most relevant. The Applicant also labeled the references and annotated each reference to focus the Examiner on the highlighted passages that are most relevant.

The Applicant notes that the eight references are independent in that they are publications authored without any input from the Declarant. The Applicant also notes that the instant claims refer to a “silicone rubber” composition. In paragraph [0002] of the specification, the inventors explain that such silicone rubbers are often referred to as silicone elastomers. Accordingly, in the references, the terms silicone elastomers and silicone rubbers can generally be interchanged.

⁴ The Declaration and eight independent references provide overwhelming evidence of the knowledge of those of skill in the art and show, based on that evidence, that one of ordinary skill in the silicone arts would not have been able to arrive at the claimed invention. See, e.g., *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 92 USPQ2d 1849 (Fed. Cir. 2009) (indicating evidence in support of rationale for non-obviousness may be particularly important in cases involving complex technology).

This interchangeability of terms is already a matter of record with the Examiner.

Consideration of the Previously Filed Reply Brief:

For the sake of brevity, the Applicant does not reproduce the remarks and arguments set forth in the previously filed Appeal and Reply Briefs. Instead, the Applicant respectfully requests that the Examiner carefully review and consider such remarks and arguments in conjunction with the instant Response.

Conclusion:

In view of the instant Remarks and those remarks and arguments set forth throughout the file history and specifically in the previously filed Appeal and Reply Briefs, the Applicant respectfully submits that all pending claims are novel and non-obvious and should be allowed. While it is believed that no further fees are presently due, the Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

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